



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/313,131	05/17/1999	ERAN STEINBERG	4473-27	3485

7590 12/03/2002

DAVID H. JAFFER  
PILLSBURY WINTHROP LLP  
2550 HANOVER STREET  
PAL ALTO, CA 94304-1115

EXAMINER

NGUYEN, LUONG TRUNG

ART UNIT	PAPER NUMBER
----------	--------------

2612

DATE MAILED: 12/03/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
09/313,131

Applicant(s)  
Steinberg

Examiner  
Luong Nguyen

Art Unit  
2612



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Sep 23, 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1, 3-6, 11, 17-22, and 30 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3-6, 11, 17-22, and 30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other:

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments filed on 9/23/2002 have been fully considered but they are not persuasive.

In re page 6, Applicant argues that in the present invention, images are not transferred.

In response, it should be noted that this feature is not recited in claims. In this case, regarding claim 1, the Applicant only amended claim 1 with the limitation "sending and receiving messages through a communication network, said messages not including digital image data from said digital image acquisition apparatus." This feature is taught by Reeley et al. (Figure 4, Column 3, line 64 through Column 4, line 46).

In re pages 6-7, Applicant argues that "Reeley does not teach or suggest a photographic system through which the service provider has new means of communication directly with the camera owner, using the integrated camera unit to provide the communication. The object of the present invention is to provide a system for maintaining communication between a service provider such as a film house, billing center, or camera manufacture and a camera user. This combination is not taught or suggested in Reeley or Ilcisin, and adds a new and useful functionality which is not present in the prior art."

In response to Applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., provide a

system for maintaining communication between a service provider such as a film house, billing center, or camera manufacture and a camera user, see application at page 3, lines 2-5) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). In this case, regarding claim 1, Applicant amended claim 1 to recite an integrated digital camera apparatus comprising “a digital image acquisition apparatus” and “a messaging apparatus independent of said digital image acquisition apparatus built into said housing.” The Examiner considers claim 1 as amended still do not distinguish over Reeley et al. patent in view of Ilcisin patent. Reeley et al. discloses a digital image acquisition apparatus as camera unit 10 (Figure 2, column 4, lines 47-51); a messaging apparatus independent of said digital image acquisition apparatus built into said housing (cellular phone 28, Figure 2, column 4, lines 47-51).

2. It should be noted that claim 36 is dependent on claim 33-34; claim 33-34 are canceled by the amendment filed on 9/23/2002. Therefore, the Examiner considers that claim 36 is also canceled.

***Claim Rejections - 35 USC § 112***

3. Claims 1, 3-6, 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite

for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 (lines 13-14) recites the limitation "said" in "said message center".

Claim 6 (line 3) recites the limitation "said" in "said image".

There is insufficient antecedent basis for this limitation in the claim.

Claims 3-6, 11 are rejected as being dependent on claim 1.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 3-6, 11, 17-22, 30 are rejected under 35 USC 103(a) as being unpatentable over Reeley et al. (U.S. 5,893,037) in view of Ilcisin et al. (US 5,880,770).

Regarding Claim 1, Reeley et al. disclose an integrated digital camera apparatus comprising a housing (See Figure 2, column 4, lines 49-51); a digital image acquisition apparatus (camera unit 10, Figure 2, column 4, lines 47-51) built into the housing, the digital image acquisition apparatus including image capture apparatus for converting a light image to digital image data

(image sensor 44, Figure 3, column 3, lines 15-20); a messaging apparatus independent of said digital image acquisition apparatus (cellular phone 28, Figure 2, column 4, lines 47-51) built into the housing, said messaging apparatus including a transceiver apparatus (transmitter/receiver circuit 54, Figures 4-5, column 3, lines 64-67 ) limited to sending and receiving messages through a communication network (See Figure 4, column 3, line 64 through column 4, line 31), said messages not including digital image data from said digital image acquisition apparatus (Figures 3-5, Column 3, line 64 through Column 4, line 46); and a code apparatus for selectively receiving messages sent to the transceiver by a message center (see column 5, lines 25-35 and note that a code is present in the form of dialing the appropriate phone number).

Reele et al. do not disclose an automatic signal transmission apparatus for automatically causing the transceiver to transmit a message request signal to the message center conveying an identification of the camera apparatus when the transceiver is turned on. However it is well known in the art to operate a videophone system in such a manner, as disclosed in Ilcisin et al. in order to make sure that necessary messages are received by the person initiating the call (See Column 2, Line 49 through Column 3, Line 12 and note that note that a camera's identification is inherently conveyed in the initiation of a call from the particular apparatus with which the camera is associated). Such a provision for the Reelee et al. device would clearly increase its utility by increasing the kinds of information available to the users of the videophone network. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide in the Reelee et al. device an automatic signal transmission means for automatically causing the

transceiver to transmit a message request signal to the message center conveying an identification of the camera when the transceiver is turned on in order to increase the utility of the device by increasing the kinds of information made available to the user.

Regarding Claim 3, Ilcisin et al. disclose a user activated apparatus for causing the transceiver to transmit a message request signal to the message center conveying an identification of the camera (See Column 2, Lines 49-56 ).

Regarding Claim 4, Reelee et al. disclose all of the limitations except apparatus disabling the automatic signal transmission apparatus when a user does not want to receive messages. However it is well known in the art to operate a videophone system so as to send messages automatically, as disclosed in Ilcisin et al. in order to make sure that necessary messages are received by the person initiating the call (Column 2, Line 49 - Column 3, Lines 12). Such a provision for the Reelee et al. device would clearly increase its utility by increasing the kinds of information made available to the users of the videophone network. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide in the Reelee et al. device an automatic signal transmission apparatus for automatically causing the transceiver to transmit a message request signal to the message center conveying an identification of the camera when the camera is turned on in order to increase the utility of the device by increasing the kinds of information made available to the user. In Ilcisin et al. this feature may be disabled when the

user does not want to receive messages (See Column 3, Lines 65-67 and note that longer-time-period messages may not be acceptable).

Regarding Claim 5, Reeley et al. are silent regarding a model number of the camera and therefore do not disclose that the code apparatus includes identification of a model number of the camera. However it is common practice in the art to form a videophone device using a camera that is separately manufactured, such as the AT&T 2500 disclosed in Ilcisin et al. (See Column 4, Lines 29-31 of Ilcisin et al. and page 25 of AT&T Technical Journal where the camera is said to be separately manufactured by Sony), the camera clearly having a model number given thereto by its manufacturer. In view of the teaching in Ilcisin et al., it would have been obvious to one of ordinary skill in the art at the time of the invention to provide a separately manufactured camera for the Reeley et al. device since it is well known in the art to so form videophone devices. In such an arrangement the code apparatus would clearly include identification of a model number of the camera since in order for there to be proper reception and display of pictures the model number of the camera used in the manufacture of the sending integrated digital camera apparatus must be the same as that of the receiving integrated digital camera apparatus. The ability to receive, process and display meaningful pictures from a sending camera identifies it having the same model as that of the integrated digital camera apparatus for such a specific videophone network.

Regarding Claim 6, Reeley et al. disclose a display apparatus for displaying the messages



(display 30, Figure 2, Column 4, lines 15-20) and an apparatus for displaying the image (display 20, Figure 2, Column 5, lines 10-15, Column 6, lines 5-10).

Regarding Claim 11, Ilcisin et al. disclose an interactive message response apparatus for responding to a question received in a message from the message center (Column 7, lines 40-45).

As for claim 17, all the limitations are contained in claim 1, therefore, see Examiner's comments regarding claim 1, except for the feature a message center including apparatus for collecting, preparing and sorting messages to be sent to a transceiver in an assembly including a digital camera which is disclosed in Ilcisin et al. (Column 2, Line 49 through Column 3, Line 33; Column 8, Lines 13-35) and a first communication apparatus responsive to reception of a message request signal conveying a camera identification for transmitting messages to the transceiver (Ilcisin et al., See Column 2, Lines 49-56 and note that the calling device's camera identification is inherently provided in the initiation of a call from a particular apparatus with which it is associated).

Regarding Claim 18, Ilcisin et al. disclose that the message center includes a capability to send a selected message to a specific integrated hand held assembly based on the code (Column 2, Lines 49-52).

Regarding Claim 19, Ilcisin et al. disclose that the message center further includes a capability to send a message simultaneously to a plurality of integrated hand held assemblies by transmitting a corresponding particular code (Column 8, Lines 13-35).

Regarding Claim 20, Ilcisin et al. disclose that the message center further includes a capability to prioritize messages as part of a single packet of multiple messages (Column 8, Lines 13-35).

Regarding Claim 21, Ilcisin et al. disclose that the integrated hand held assembly further includes means for disabling the automatic signal transmission apparatus (Column 1, Lines 60-61).

Regarding Claim 22, Ilcisin et al. disclose that the integrated hand held assembly further includes a message display apparatus (display 20).

Regarding Claim 30, Ilcisin et al. disclose an interactive message response apparatus for responding to a question received in a message from the message center (Column 7, Lines 40-45).

### ***Conclusion***

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Luong Nguyen** whose telephone number is (703) 308-9297. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Wendy Garber**, can be reach on (703) 305-4929.

**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

**or faxed to:**

(703) 872 - 9314


Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal drive,  
Arlington, VA., Sixth Floor (Receptionist).

Application/Control Number: 09/313,131  
Art Unit: 2612

11

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.

LN LN  
11/26/02

  
WENDY R. GARBER  
SENIOR PATENT EXAMINER  
TECHNOLOGY CENTER 2600